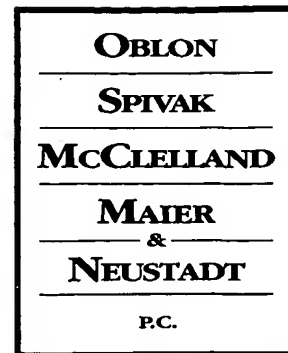




IFW



Docket No.: 250241US3CONT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

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RE: Application Serial No.: 10/798,556

Applicants: Hiromasa SATO, et al.

Filing Date: March 12, 2004

For: DIFFRACTION ELEMENT

Group Art Unit: 2872

Examiner: CHANG, A.

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT P.C.

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DOCKET NO. 230241US3CONT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HIROMASA SATO ET AL : EXAMINER: CHANG, A.
SERIAL NO: 10/798,556 :
FILED: MARCH 12, 2004 : GROUP ART UNIT: 2872
FOR: DIFFRACTION ELEMENT :

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Election Requirement dated August 19, 2004, Applicants elect without traverse Species A, identified in the outstanding Official Action as corresponding to Figure 1, for further examination on the merits. Applicants identify Claims 1-7 as readable on the elected species. Applicants reserve the right to file one or more divisional applications directed to the non-elected species.

Furthermore, while the Election Requirement asserts that the application contains claims to patentably distinct species, MPEP § 803 states the following:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Although the outstanding Official Action does not identify search classifications, it is believed that the claims of the present application would have to be searched in a handful of sub-classes. Furthermore, since electronic searching is commonly performed, a search may be made of a large number of, or theoretically all, subclasses without substantial additional

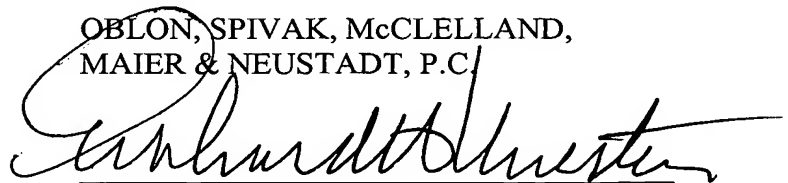
Application No. 10/798,556
Reply to Office Action of August 19, 2004

effort. Accordingly, Applicants respectfully traverse the Election Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, whereas it would be a serious burden on Applicants to prosecute and maintain separate applications.

Therefore, it is respectfully requested that the requirement to elect a single species be withdrawn, and that a full examination on the merits of Claims 1-11 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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